



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: Barbara A. Gilchrest, Mina Yaar and Mark Eller

2001-7-23

Application No.: 09/018,194

Group Art Unit:

TECH CENTER 1600 2900

Filed: February 4, 1998

Examiner:

S. Weger

For: Methods of Inducing Hair Growth and Coloration

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents.

Washington, D.C. 20231

on 8/20/01

Date

Signature

Kathleen M. Bastarache  
 Typed or printed name of person signing certificate
**REPLY TO RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Responsive to the Office Communication dated 20 July 2001, the claims of Group II (Claims 6-10) drawn to methods of inducing hair growth, are elected for prosecution.

In response to the "secondary restrictions . . . required under 35 USC 121," Applicants elect item C from A-D, as recited on page 3 of the Restriction Requirement dated 5 June 2001. Item C is "The Inventions named above as they pertain to Sequence ID No. 9."

If the "secondary restrictions . . . required under 35 USC 121" are being considered species, claims readable on the elected species "SEQ ID NO:9" are Claims 7-10.

Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

The requirement is being traversed for the reasons set forth in detail below.

For the claims of groups I, V and VI, the step of the method is the same -- that is, inhibiting apoptosis in epidermal melanocytes, and more specifically, contacting epidermal melanocytes with a substance, in an amount sufficient to inhibit cell loss, which binds to p75 nerve growth factor receptor expressed on the surface of the melanocytes. For each group of claims, the cell type to be acted on is the same -- that is, epidermal melanocytes. Further, the effects sought in the methods as stated in the preambles of Claims 1, 20 and 25 are very closely related. With the same step in the method, the same target cell, and very closely related effects sought, separate prior art searches would not be required for the claims of groups I, V and VI.

Similarly, for the claims of groups II and VIII, the step of the method is the same -- that is, inhibiting apoptosis in epidermal keratinocytes, and more specifically, contacting epidermal keratinocytes with a substance, in an amount sufficient to inhibit cell loss, which binds to p75 nerve growth factor receptor expressed on the surface of the keratinocytes. For each group of claims, the cell type to be acted on is the same -- that is, epidermal keratinocytes. Further, the effects sought in the methods as stated in the preambles of Claims 6, 33, 45 and 49 are very closely related. With the same step in the method, the same target cell, and very closely related effects sought, separate prior art searches would not be required for the claims of groups II and VIII.

For the claims of groups III and IV, the step of the method is the same -- that is, inhibiting apoptosis in epidermal melanocytes, and more specifically, contacting epidermal melanocytes with a substance, in an amount sufficient to inhibit cell loss, which binds to p75 nerve growth factor receptor expressed on the surface of the melanocytes. For both groups of claims, the cell type to be acted on is the same -- that is, epidermal melanocytes. The effects sought in the methods -- inducing hair color and maintaining hair color -- are closely related. With the same step, the same target cell, and very closely related objectives, separate prior art searches would not be required for the claims of groups III and IV.

Applicants respectfully request that the Examiner reconsider the grouping of the claims as presented in the Office Action of June 5, 2001. Applicants propose that groups I, V and VI be combined, groups II and VIII be combined, and groups III and IV be combined to form the following groups of claims:

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<u>New Group</u>	<u>Old Groups</u>
I	I + V + VI
II	II + VIII
III	III + IV
IV	VII

In addition, Applicants traverse the "secondary restriction" as set forth on page 3 of the Restriction Requirement of 5 June 2001.

According to *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996), the Commissioner determined that normally, ten nucleotide sequences constitute a reasonable number for examination purposes. This guideline was made in the interest of aiding the biotechnology industry, without imposing an undue burden on the Patent Office. Applicants believe that the prior art search and examination of Claim 10, considering only the three peptides SEQ ID NO:4, SEQ ID NO:9 and SEQ ID NO:10 together, would be in keeping with these interests voiced by the Commissioner in 1996. Applicants therefore request that the "secondary restriction" as it may apply to Claims 7-10 be withdrawn.

Respectfully submitted,

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